

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARIE-PASCALE AUDOUSSET



Appeal No. 2005-0702
Application No. 09/443,505

HEARD: May 4, 2005

Before KIMLIN, KRATZ, and TIMM, *Administrative Patent Judges*.
TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal involves claims 1-3 and 5-18 which are all the claims pending in the application. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 134.

INTRODUCTION

The claims are rejected under 35 U.S.C. § 103(a). As evidence of obviousness, the Examiner relies upon the following prior art references:

Clausen et al. (Clausen)	4,997,451	Mar. 05, 1991
Akram et al. (Akram)	5,230,710	Jul. 27, 1993
Lim et al. (Lim)	6,074,438	Jun. 13, 2000 (filed Mar. 03, 1998)

Specifically, claims 1-3 and 5-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lim in view of Akram and also over those references further in view of Clausen.

Appellant states that the claims stand or fall together (Brief, p. 4). We select claim 1 to represent the issues on appeal. Claim 1 is directed to a composition containing at least one oxidation base and a coupler. The oxidation base is limited to one selected from a list of substituted para-aminophenols. The coupler is limited to 1, 3 bis(β -hydroxyethyl)amino-2-methylbenzene and an addition salt thereof. The claim excludes certain oxidation bases. Claim 1 reads as follows:

1. A composition for the oxidation dyeing of keratin fibres comprising, in a medium which is suitable for dyeing:

(a) at least one oxidation base chosen from 4-amino-3-methylphenol, 4-amino-3-fluorophenol, 4-amino-3-hydroxymethylphenol, 4-amino-2-methylphenol, 4-amino-2-hydroxymethylphenol, 4-amino-2-methoxymethylphenol, 4-amino-2-aminomethylphenol, 4-amino-2-(β -

hydroxyethylaminomethyl)phenol and 4-amino-2-fluorophenol, and an addition salt thereof with an acid; and

(b) a coupler chosen from 1,3-bis(β -hydroxyethyl) amino-2-methylbenzene and an addition salt thereof with an acid;

wherein said composition does not include an oxidation base chosen from pyrimidine, pyrimidine derivatives, 2- β -hydroxyethyl-para-phenylenediamine, an addition salt thereof with an acid, and 1-5-amino-2- hydroxyphenyl)ethane-1,2-diol.

OPINION

We affirm substantially for the reasons advanced by the Examiner in the Answer and add the following primarily for emphasis.

There is no dispute that Lim describes each component of the claimed composition. What Appellant argues is that the Examiner has provided no evidence that the prior art also suggests the desirability of the use of the claimed components together (Brief, pp. 6-7). We disagree.

Lim discloses that “the hair dyeing composition described herein may also contain at least one other known and usual dye ingredient (i.e., used as primary dye intermediates and/or couplers), as well as conventional direct-dyes in admixture, should these substances be necessary or desired for the development and production of certain color nuances and tints.” (Lim, col. 4, l. 67 to col. 5, l. 6). Lim then lists illustrative component dye ingredients that are suitable for use (Lim, col. 5, ll. 7-11). Among those listed are four of the substituted para-aminophenols recited in claim 1 (Lim, col. 5, 32-38) and 2, 6-bis(hydroxyethylamino)toluene (Lim, col. 6, l. 24) which the Examiner finds, without dispute by Appellant, is the 1, 3-bis(β -hydroxyethyl)amino-2-

methylbenzene coupler of claim 1. Lim provides evidence that those of ordinary skill in the art would have selected the listed ingredients for use in the hair dye of Lim in order to obtain “certain color nuances and tints.” (Lim, col. 5, ll. 4-6).

Moreover, we agree with the Examiner that Akram provides further evidence supporting the use of the claimed coupler in the composition of Lim. Akram indicates that couplers of the type claimed by Appellant were known to form “intensive brown, blonde, violet and blue shades of high heat stability and fastness to light with a large number of the known developer [oxidation base] substances” and that their compatibility with “further couplers and direct dyestuffs is very good, and controlled modifications of the shades of known developer/coupler systems are therefore also possible.” (Akram, col. 4, ll. 7-22). Akram, therefore, provides further evidence of a reason or motivation to include the claimed coupler in the composition of Lim as well as a reasonable expectation of success.

Appellant cites *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002) in support of their argument that the Examiner did not make a “thorough and searching” factual inquiry. We do not agree. The point made in *Lee* was that the Examiner cannot rely on his or her own knowledge, based on unknown authority, to establish that there was a reason, suggestion or motivation to make a modification: The Examiner must provide adequate underlying factual support for the finding. *Lee*, 277 F.3d at 1343, 61 USPQ2d at 1433-34. The underlying evidence may be an objective teaching in the prior art or it may be grounded in evidence of knowledge generally available to one of ordinary skill in the art. *Lee*, 277 F.3d 1338, 1343, 61 USPQ2d

1430, 1433(citing *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2s 1780, 1783 (Fed. Cir. 1992)); see also *In re Huston*, 308 F.3d 1267, 1280, 64 USPQ2d 1801, 1810 (Fed. Cir. 2002)(The motivation, suggestion or teaching may come explicitly from statements in the prior art, from the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved). The key is that there must be some basis in the prior art; the question cannot be resolved on subjective belief and unknown authority nor may the examiner use “that which the inventor taught against its teacher.” *Lee*, 277 F.3d at 1344, 61 USPQ2d at 1434(quoted *W.L. Gore & Assocs. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984); see also *In re Huston*, 308 F.3d at 1280, 64 USPQ2d at 1810. The Examiner has provided a basis in the prior art supporting the finding of a reason, suggestion, or motivation to include an oxidation base and coupler as claimed in the composition of Lim: those very ingredients are suggested by Lim as useful and such is also suggested by Akram. Nor was it error, contrary to the arguments of Appellant, for the Examiner to give weight to the knowledge of those of ordinary skill in the hair dye art as evidenced by the references. The suggestion to combine need not be express and “may come from the prior art, as filtered through the knowledge of one skilled in the art.” *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997).

Appellant also argues that “[n]othing in Lim would have led one of ordinary skill in the art to select the claimed at least one oxidation base from among the myriad of other optional ingredients disclosed in the reference.” (Brief, p. 9). But Lim suggests that each of the

ingredients is useful. That the prior art discloses other optional ingredients does not somehow reduce the obviousness of using the specifically suggested oxidation bases. *See Merck & Co., Inc. v. Biocraft Labs, Inc.*, 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir.1989), *cert. denied*, 493 U.S. 975 (1989).

Appellant further argues that the Examiner has not presented a convincing line of reasoning as to why a beneficial result would have been produced by combining the ingredients disclosed in Lim and Akram (Brief, p. 10). First, this argument overlooks the fact that both Lim and Akram disclose the claimed coupler. Akram is not being used in the rejection to supply an ingredient missing from the dyeing composition of Lim, but to provide further evidentiary support for the motivation for using the ingredients disclosed by Lim. Second, the disclosure of Akram is not as limiting as Appellant characterizes it. Akram may not expressly exemplify the use of the coupler with the claimed substituted para-aminophenols, however, there is a non-limiting mention of para-aminophenols and functionalized para-aminophenols (Akram, col. 9, l. 15 and ll. 18-23) and a statement that the coupler will “form intensive brown, blonde, violet and blue shades of high heat stability and fastness to light with a large number of the known developer substances.” (Akram, col. 4, ll. 7-18).

Appellant further argues that the desire to modify shades would not have motivated one to combine the cited references with a reasonable expectation of success (Brief, p. 11). According to Appellant, “while it is true that couplers may be used to modify the shade or color of an oxidation dye composition comprising an oxidation dye precursor, couplers are not the only

means for modifying the shade or color of an oxidation dye composition.” (Brief, p. 12). But the fact that there might be other methods does not somehow nullify the obviousness of using the known method using known couplers. Nor does the fact that different oxidation bases give different colors nullify obviousness where that fact was known in the art. (Answer, p. 9; Claussen, col. 5, ll. 41-68).

Appellant further draws our attention to Examples 3 and 4 reported on page 18 of the specification (Brief, p. 12). According to Appellant, a comparison of these two examples indicates that the composition of Example 3 which contains an oxidation base outside the scope of the invention with Example 4 which contains an oxidation base within the scope of the claim shows that the color is less fast for the Example 3 oxidation base. Appellants then argue that given the general unpredictability of the hair dye art and the results of Examples 3 and 4 “there would not even have been an expectation of success for choosing one para-aminophenol derivative from among the para-aminophenol derivatives disclosed in *Lim*, let alone simply choosing one from among the many optional ingredients disclosed in *Lim*.” (Brief, p. 13). This argument is not persuasive because the comparison sheds little light on the interaction of the oxidation base and coupler combination in the context of the *Lim* composition. The *Lim* composition has additional oxidation base and coupler components present.

Appellant further argues that Claussen “teaches away” from the use of other substituted para-aminophenols (Brief, p. 14). But Claussen does not disclose that other substituted para-aminophenols will not work, Claussen simply states that the described substituted para-

aminophenols are improved. Moreover, one of the described substituted para-aminophenols, i.e., 4-amino-2-methoxymethylphenol (col. 2, ll. 32-33) is one of the claimed substituted para-aminophenols.


As a final point, we note that Appellants base no arguments upon objective evidence of non-obviousness such as unexpected results. We conclude that the Examiner has established a *prima facie* case of obviousness with respect to the subject matter of claims 1-5 and 5-18 which has not been sufficiently rebutted by Appellants.

CONCLUSION


To summarize, the decision of the Examiner to reject claims 1-5 and 5-18 under 35 U.S.C. § 103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1) (iv).

AFFIRMED


EDWARD C. KIMLIN
Administrative Patent Judge


PETER F. KRATZ
Administrative Patent Judge


CATHERINE TIMM
Administrative Patent Judge

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Appeal No. 2005-0702
Application No. 09/443,505

Page 10

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413